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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/325,040
Filing Date: June 07, 1999
Appellant(s): BREWSTER ET AL.

Att. D. L.

GROUP 3600

Curtis G. Rose
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 23, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,157,924	AUSTIN	12-2000
5,721,827	LOGAN et al	2-1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 1-3, 12-15, 33, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow et al (5,850,520) in view of Austin (6,157,924).

Claim 1: Griebenow discloses a method for automatically printing a document, comprising:

- a. Storing a print schedule with an indication that the document should be printed at a user requested time (e.g. monthly)(col 4, lines 25-31 and col 8, lines 19-33);
 - b. Automatically requesting and receiving the document without user intervention (col 4, lines 32-45 and col 8, lines 19-33).

Griebelnow discloses the document being automatically sent to the user's computer or to a predetermined location and that the user's computer includes a printer (col 3, lines 25-34), but does not explicitly disclose that the document will also be automatically printed on the user's printing device. Austin discloses a similar method for automatically delivering information using "Push" technology (col 10, lines 45-54) to a user in which the method of delivery (e.g. print) and frequency of delivery (e.g. monthly)(See Figure 4A) is chosen by the user and stored in the user profile. When the desired information is to be retrieved and sent to the user, it is formatted into the desired format; explicitly "If a determination is made that the delivery medium is to be printed copy (Block 160), the retrieved information, and any additional information, is formatted

as a printed copy (Block 162). The printed copy is then delivered to a user's printer (Block 164)" (col 13, lines 35-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically send the document in Griebelnow to the user's printer if the user had indicated his desire to receive a printed copy. One would have been motivated to send the document directly to the printer in order to deliver the document in the preferred medium and to eliminate the need for the user to perform the tedious steps of downloading each file, opening each file, and selecting the print button to manually print each file.

Claim 2: Griebelnow and Austin disclose a method for automatically printing a document as in Claim 1 above, and Griebelnow further discloses storing a user profile (col 6, lines 65-67).

Claims 3, 77, and 78: Griebelnow and Austin disclose a method for automatically printing a document as in Claim 2 above, and Griebelnow further discloses updating the user profile to reflect the delivery (printing) of the document (using a return receipt)(col 7, lines 10-55). Furthermore, Austin also discloses that the system will verify the successful delivery of the document to the user's printer (col 13, lines 13-17) and that this information is used to update the customer file (col 15, lines 13-23).

Claim 12: Griebelnow and Austin disclose a method for automatically printing a document as in Claim 2 above, and Griebelnow further discloses including advertising content in the document (col 5, lines 12-22).

Claims 13, 14, and 33: Griebelnow and Austin disclose a method for automatically printing a document as in Claims 3 and 12 above, and Griebelnow further

discloses personalizing the advertising content and the document content based on the user profile (col 5, lines 12-22 and col 6, lines 65-67).

Claim 15: Griebelnow and Austin disclose a method for automatically printing a document as in Claim 13 above, and Griebelnow further discloses updating the user profile to reflect the delivery (printing) of the document (using a return receipt)(col 7, lines 10-55). Furthermore, Austin also discloses that the system will verify the successful delivery of the document to the user's printer (col 13, lines 13-17) and that his information is used to update the customer file (col 15, lines 13-23).

Claims 79 and 80: Griebelnow and Austin disclose a method for automatically printing a document as in Claim 78 above, but do not explicitly disclose that the user requests a delivery time on a specific day of the week or month or after a specified lapse of time. However, while Griebelnow gives an example of the user ordering a monthly publication, it would have been obvious that the publication could have other publication periods, such as weekly, daily, quarterly, or any other time period designated by either the publisher or the user (such as the user requesting a portfolio update from his broker every Wednesday or at 8:00 a.m. each weekday morning). One would have been motivated to delivery the requested document using other periods of time, such as the claimed day of the week or month, in order to met the needs of the user and to allow other periodicals, such as daily electronic newspapers, to participate in the Griebelnow invention.

(b) Claims 34-38 and 43-48 are rejected under 35 U.S.C. 103(a) as being anticipated by Logan et al (5,721,827).

Claim 34: Logan discloses a method for subsidizing printing of documents, comprising:

- a. Monitoring the usage of a printing device (col 26, lines 53-59); and
- b. Subsidizing the purchase of a product based on the monitoring step (col 26, lines 53-59).

While Logan discloses monitoring the usage of an audio device instead of a printing device, both devices are being used to deliver a desired electronic content file to a user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the method steps in Logan could be used to monitor any electronic information delivery device to include a printer, an audio device, a video device, a computer, or even a copier or fax machine. One would have been motivated to monitor the usage of other types of devices, such as a printer, in view of Logan's disclosure that the downloaded files could contain audio, text, or both.

Claims 35-38: Logan discloses a method for subsidizing printing of documents as in Claim 34 above, and further discloses updating a user profile with an indication that an advertisement has been printed in the document and with the amount of resources (e.g. ink, paper, etc.) that has been used to print the document (col 26, lines 53-59).

Again as discussed in Claim 34 above, while Logan discloses tracking and storing (in a usage log) the costs to deliver an audio file, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the same steps could be

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used to determine the cost of delivering other electronic files to include the costs of printing an electronic document, such as amount of ink and/or paper used.

Claims 43-45: Logan discloses a method for subsidizing printing of documents as in Claim 34 above, and further discloses various funding sources, such as advertising and distribution revenues (col 6, lines 1-9 and col 20, lines 3-7).

Claims 46-48: Logan discloses a method for subsidizing printing of documents as in Claim 35 above, and further discloses providing the monitored information to a third party, such as an advertiser or content provider (col 27, lines 4-27).

(c) Claims 4-11, 16-22, 39-42, and 81-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow et al (5,850,520) in view of Austin (6,157,924) and in further view of Logan et al (5,721,827).

Claims 4 and 16: Griebenow and Austin disclose a method for automatically printing a document as in Claims 3 and 15 above, but do not explicitly disclose subsidizing a product for a user based on updating the user profile. However, Logan discloses a similar method for delivering documents which include advertisements like Griebenow and which also discloses subsidizing a product (programs heard) based on updating the user profile (col 26, lines 53-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the advertising revenue discussed in Griebenow (col 6, lines 2-12) to subsidize the cost to the user for printing the document. One would have been motivated to subsidize the user's cost in this way in order to entice the customers to use the system.

Claims 5-11, 17-22, 39-42, and 81-85: Griebelnow, Austin, and Logan disclose a method for automatically printing and subsidizing a document as in Claims 4, 16, and 34 above. All three references further disclose sending various types of advertising and promotional products, such as a free or discounted print consumable, printable media (e.g. coupon), or product to the user (Griebelnow, col 10, line 58 - col 11, line 22)(Austin, col 10, lines 34-44 and 59-67)(Logan, col 24, lines 1-14). While none of the references explicitly discloses that the advertising content includes a coupon, coupons are old and well known form of advertisements and would have been an obvious choice for the advertisers in Griebelnow or in Logan. One would have been motivated to present a coupon to the user in order to entice the user to buy the product by clicking on the “purchase” or “order” link discussed in each reference. The Examiner further notes that the type of product or service being offered as an incentive, whether a print consumable, a printing device, or any other type product or service (or a coupon for such) does not affect the steps of providing the incentive to the user. It is obvious that the targeted advertisement in Griebelnow could be for any product or service desired by the advertiser.

(11) Response to Argument

(a) The Appellant argues that Griebelnow does not “disclose that the electronic document is intended to be printed, and in fact teaches away from this view by constantly referring to the document as an ‘electronic document’” (pages 4-5). The Examiner notes that while the Appellant’s claims refer to the document as “a document”

in reality it is also an electronic document as it is being stored, requested, and transmitted (Claim 1). In fact, it is also an electronic document as it is being printed. Only after the electronic document is output from the system (e.g. through a printer) is it no longer an electronic document. Griebelnow explicitly discloses that the general purpose computer being used as the consumer's computer **12** comprises the normal components to include "input/output devices, such as printer **40**, disk drives **38**, display **42**, and communications link **44**" (col 3, lines 30-34). Griebelnow further discloses that, instead of using email, the publication (i.e. electronic document) "could be downloaded directly to the consumer's computer or to a predetermined location to which the computer's processor is connected" (col 5, lines 59-65). Thus, while downloading the electronic document to an email address is used as an exemplary embodiment of the Griebelnow invention, it is also disclosed that the electronic document could be downloaded to any location connected to the processor, which would include the above mentioned input/output devices (printer, disk drivers, display, and communications link). The Examiner further notes that Claim 1 was rejected as being obvious over Griebelnow in view of Austin. Austin explicitly discloses that if the electronic document is to be delivered as a printed copy (based on the method of delivery selected by the user), "the printed copy is then delivered to a user's printer" (col 13, lines 35-39). The Appellant acknowledges this disclosure by Austin, but then argues that Austin does not disclose "how the document could be printed at a user-specified time" (pages 5 and 7). The Examiner notes that in the final rejection both references were shown to disclose this feature. Griebelnow discloses that the "timing engine **50** will create events at the

appropriate time intervals when delivery of the electronic publication is proper" (col 4, lines 25-34), and Austin discloses the user being able to modify delivery options. Figure 4D shows that one of the characteristics of the statement distribution system is the "Delivery Frequency", which is listed on the exemplary figure as "Monthly". In other examples, Austin uses financial statements, such as investment reports, which, as is well known, may be issued monthly, quarterly, or annually, depending on the desires of the user. Therefore, it would have been obvious at the time of the invention based on these two disclosures to delivery the electronic document at a user-specified time (e.g. monthly).

(b) The Appellant argues that the Examiner is "using hindsight gleaned from the knowledge of the Appellant's specification to form the basis of the rejections" (page 8). The Examiner notes that in the previous argument the Appellant acknowledges that the references disclose the steps of Claim 1 with the exception of the printing being accomplished "at a user requested time". The feature of letting a user designate a time or frequency for delivery of a newspaper, a publication, a report, a financial statement, etc. has been well known in society for decades, if not for centuries. One having ordinary skill in the art at the time the invention was made would not only have known of many other systems which incorporate this feature, but would also have known the advantages to the user in being able to select the desired frequency. For example, when setting up an investment portfolio, it is common for the user (investor) to indicate his preference for receiving the investment report (e.g. weekly, monthly, quarterly, annually, etc.). Different investors would have different desires on the frequency. A

casual investor which invests a lump sum once a month (such as in an employee savings plan) would be happy receiving the report monthly or even quarterly. However, an active investor who makes investments and withdrawals daily would desire to receive his statement weekly, daily, or possibly even several times a day. Thus, it would have been obvious to receive such a selection when setting up the delivery of the publications in the references or in the Appellant's invention in order to better tailor the system to meet the needs of each user.

(c) The Appellant argues that Logan "monitors an audio device" and provides no "motivation to monitor a printer instead" (page 8). The Examiner notes that in the final rejection it was noted that Logan monitored the usage of an audio device connected to the network in order to give credit to the subscriber (user) to reduce the cost of the audio files being delivered to the subscriber, as cited by the Appellant in the Brief. It was further noted that both Logan's audio device and the Appellant's printer were network output devices which were being used to deliver an electronic document to the user, and that the method steps disclosed by Logan could be used to monitor any type of network output device to include a printer, an audio device, a video device, a computer, a copier, or a fax machine. It was also noted that Logan disclosed that the files being downloaded (i.e. electronic document) could contain audio, text, or both. Thus, while an audio file may be delivered through an audio device, a text file would either need to be converted into an audio file or else be delivered through another output device such as a video display or printer. Therefore, the Examiner considered it obvious to one having ordinary skill in the art to also use the method steps in Logan to

monitor these other output devices to include a printer in order to facilitate the correct billing of the subscriber as taught by Logan.

(d) The Appellant argues that neither Griebelnow nor Austin discloses “updating the user profile with an indication that the document printed successfully” (pages 10-13). The Examiner notes that Griebelnow explicitly discloses that the system will “generate a message from the consumer’s computer **12** to publisher’s computer **14** indicating that a consumer has accessed the electronic publication, or even a particular item in the electronic publication such as a content item or an advertisement. This feature of the invention could be used by advertisers and publishers to monitor consumer response to advertisements or content items. Publishers might even bill for advertising based upon a consumer’s viewing of the advertisement” (col 6, lines 4-11); and “The publication may optionally be sent return receipt requested to provide the publisher with electronic verification that the publication has indeed been delivered to or received by the consumer” (col 7, lines 62-65). This clearly shows that Griebelnow is not only monitoring the usage of the electronic document, but is also reporting the usage back to the publisher’s computer, which is then “stored in storage **60** using database engine **48**” (col 8, lines 17-18). The Examiner notes that storage **60** contains the consumer profile and order information (col 4, lines 9-11). Thus, the system is storing the return receipt information in the database containing the user’s profile, in other words “updating” the profile in order to complete the billing of the consumer of an electronic publication. Again, it would have been obvious to one of ordinary skill in the art that when verifying that the document has been delivered to or received by the consumer to ensure that it

was successfully delivered (to the correct delivery system, e.g. a printer), since the advertiser is being billed for the delivery of their advertisement to the consumer. This is also explicitly shown in Austin as cited by the Appellant. Successful delivery to a printer would be verification that the printer successfully printed the document. Such printer monitoring means and methods are well known in the art and have been used extensively to monitor queues of documents assigned to network printers for at least the past two decades. When a document has been delivered to a printing queue, but its printing is unsuccessful (possible to an "out of paper" situation), an Error Message is usually sent to the system manager or other monitoring person/device/log. Thus, not only was it common to verify the delivery, but also to verify the printing of documents sent to a printer.

(e) The Appellant argues that none of the references teach "subsidizing the purchase of a product that is depleted upon the usage of the printing device" (pages 16-17). The Examiner notes that in the rejection it was shown that the references disclosed sending various type of advertisements and coupons to the user. It was also discussed that the type of product or service being offered as an incentive does not affect the steps of providing the incentive to the user. It would have been obvious that the incentive could be for any product or service desired by the advertiser. Additionally, since the references disclose maintaining user profiles on the users, it would have been obvious to maintain information pertaining to the user's type of equipment, such as the printer, and to use that information to select the targeted incentives distributed to the user in the references. Finally, the Examiner would like to note that difficulty and

inexactness of monitoring such consumables as paper, toner, ribbon, or ink usage and using that information to project a need by the user for more of that product. While one could make an educated guess that if the printer has printed 5,000 pages of documents, the user may be getting low on paper (5,000 pages is the usual quantity of paper in a "case"), the Appellant has not disclosed how the system would determine how much paper the user had "on hand" in the beginning or how much paper had been wasted, destroyed by the printer, or used for other projects (hand-written notes, etc.). Similar argument could be made for the usage of toner, ribbons, ink, etc. While monitoring the gross number of pages printed (printer usage) could give a person an estimate on the amount of consumables used by the printer, it is just that - - an estimate. Consumables, such as toner cartridges, are notorious for running out unexpectedly or for lasting well beyond their expected consumption date. Ink, especially, must also take into account the amount of evaporation experienced during periods of non-use. Therefore, since the references disclose monitoring the delivery of the electronic documents to the user's output device (device usage), it would have been obvious to make the advertisements and incentives the reference systems are providing to the user pertain to such consumable products.

(f) The Appellant argues that none of the references disclose tracking "the amount of ink that was used when a document was printed" (pages 18-20). The Examiner notes that this has been discussed at length in the preceding paragraph.

(g) The Appellant argues that none of the references disclose tracking and "updating the user profile to indicate the amount of each of a plurality of different colored

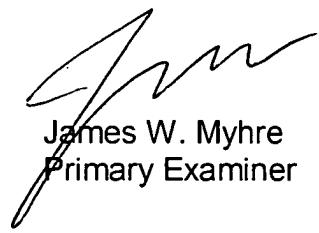
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ink that was used when a document was printed" (page 20). The Examiner notes that this is the same argument as in the two previous paragraphs and that whether the consumable being monitored is paper, toner, black ink, or various colors of ink does not affect the claimed steps of providing an incentive to the user for a product. Therefore, the same rationale discussed above has been used to reject this claim.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


JW
WM
August 3, 2004


James W. Myhre
Primary Examiner

Conferees:

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